

Request for Reconsideration and Withdrawal of the Restriction Requirement

Applicant requests reconsideration and withdrawal of the restriction requirement because the Examiner has not made a prima facie showing that Inventions I and II, as claimed, are independent or distinct.

In order to meet its burden of establishing a prima facie basis for restriction, the Patent Office must provide (1) reasons why the inventions as claimed are independent or distinct, MPEP 806; and (2) the reasons for insisting upon restriction between the inventions. MPEP 808. It is respectfully submitted that the Examiner has not satisfied either of these criteria with regard to Inventions I and II.

a) The Examiner has not made a prima facie showing that Inventions I and II are independent and distinct as claimed

35 U.S.C. Sect. 121 provides, "If two or more independent and distinct inventions are claimed in one application, the Commissioner *may* require the application to be restricted to one of the inventions." (emphasis added). Restriction is thus discretionary, *not* required.

The Patent Office interprets the term "independent" to mean that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect. MPEP 802.01. The Patent Office interprets "distinct" to mean that two or more inventions are (1) capable of separate manufacture, use or sale as claimed, and (2) patentable over each other. MPEP 802.01. Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction is never proper. MPEP 806.05; 808.02.

In asserting grounds for the restriction requirement, the Examiner relies on MPEP § 806.05(f) concerning distinctness between processes of making and products made. The Examiner has not met the Commissioner's burden of establishing a prima facie case that inventions I and II, as claimed, are independent and distinct from one another.

In support of the restriction requirement, the Examiner states only that “the product as claimed can be made by another and material different process other than using the method of threading.” The Examiner does not provide an example of how the product can be made using a method other than threading. Applicant is unable to conceive of how the product *as claimed* can be made by a method other than threading, since the applicant is specifically claiming a cord cover comprising a “permanently enclosed tube of pliable material.”

In claims 12-18 (Invention II), applicant is merely claiming a method of making the device of claims 1-11 (Invention I). It defies commonsense to hold that claims covering the same concepts embodied in the same device are somehow distinct inventions. Hyper-technical, overly legalistic restriction requirements leave inventors confounded and undermines their faith in the Patent Office. Because the Examiner has not provided an example or reasons for the restriction, the applicant is unable to further address the basis of the restriction requirement.

Under the circumstances, the Patent Office has not met its burden of demonstrating that the product as claimed can be made by another and materially different process. The burden shifts to the Examiner to document a viable alternative process or product, or withdraw the restriction requirement. MPEP § 806.05(f).

b) The Examiner has not provided reasons for insisting on restriction between Inventions I and II


If the Patent Office contends that related inventions are distinct under the criteria of MPEP 806.05, the Patent Office must *also* explain why the distinct inventions must be restricted on the basis of (a) separate classification, (b) separate status in the art, or (c) a different field of search. MPEP 808.02. In the present case, the Examiner does not provide the required explanation. The Examiner merely indicates that Invention I is classified in class 174, subclass 72c and that Invention II is classified in class 29, subclass

605. The Examiner does not address the criteria required by MPEP § 808.02. There is simply no basis for contending that the inventions must be restricted on the basis of separate classification, separate status in the art, or a different field of search because claims 12-18 merely claim methods of making the device of claims 1-11. Accordingly, the search required for Group I will be the same as the search required for Group II. If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits. MPEP 803. In this case, examination of Inventions I and II can clearly be made without serious burden on the Examiner, because Invention II merely claim a process of making the device of Invention I.

Conclusion

Because the July 16, 2002 office action does not set forth reasons why the Inventions I and II as claimed are independent or distinct and the reasons for insisting upon restriction, the Patent Office has not met its burden of establishing a prima facie basis for restriction. Accordingly, applicant requests withdrawal of the restriction requirement between Inventions I and II, and that examination proceed forward on claims 1-18.

Respectfully submitted,



Shawn D. Sentilles, Reg. No. 38,299
ADAMS and REESE, L.L.P.
4500 One Shell Square
701 Poydras Street
New Orleans, Louisiana 70139
Telephone: (504) 581-0381

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